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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,691	06/03/2002	Stephen Gill	PA-9947	3741
36335 7590 11/03/2009 GE HEALTHCARE, INC. IP DEPARTMENT 101 CARNEGIE CENTER PRINCETON, NJ 08540-6231				
EXAMINER				
JONES, DAMERON LESTY				
ART UNIT		PAPER NUMBER		
1618				
MAIL DATE		DELIVERY MODE		
11/03/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/069,691

**Applicant(s)**

GILL ET AL.

**Examiner**

D L. Jones

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the amendment filed 10/27/09 wherein Claims 1, 3, 6, 11, and 13 were amended. In addition, the Examiner acknowledges the request for continued examination under 37 CFR 1.114 filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/09 has been entered.

**Note:** Claims 1-14 are pending.

## **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS**

2. The Applicant's arguments and/or amendment filed 10/27/09 to the rejection of claims 1-14 made by the Examiner under 35 USC 103 have been fully considered and deemed non-persuasive for the reasons of record in the actions mailed 8/27/09; 7/24/08; and 12/12/07 and the reasons set forth below. Therefore, the said rejection is hereby MAINTAINED.

### **103 Rejection**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The rejection of claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over Crane (US Patent No. 5,951,952) in view of Yamaguichi et al (JP 11-99-99192) in further view of Schott Glaswerke (DE 29609958) or Walther (US Patent No. 6,200,658) is MAINTAINED for reasons of record in the actions mailed 8/27/09; 7/24/08; and 12/12/07 and the reasons set forth below.

It is duly noted that in the Board of Patent Appeals and Interferences decision on 8/27/09, the rejection of claims 1-14 over the above cited prior art documents was affirmed. Thus, in an attempt to overcome the cited prior art, the claims have been amended to include Formula ML<sub>n</sub> wherein M is the radiometal of the radiopharmaceutical and L is a non-radioactive organic ligand which is a carbon containing compound which comprises at least one heteroatom selected from N, O, S, P, or Se. The variable n is the number of ligands (L) attached to M and is an integer of value 1 to 8. Applicant asserts that the amendment to the claims place the claims in condition for allowance.

Applicant's argument is non-persuasive for the following reasons. First, review of the primary document, Crane et al, discloses that the document is directed to radiolabeled ligands, specifically, <sup>99m</sup>Tc- and <sup>186/188</sup>Re-tertiary butyl isonitrile complexes (see entire document, especially, abstract; column 1, lines 54-61). The structure of t-butyl-isonitrile is:



. Thus, the organic ligand of Crane et al meets the requirements of the amended claims which disclose that the organic ligand is a carbon-containing compound which comprises at least one heteroatom wherein the heteroatom is selected from N, O, S, P, or Se. In addition, Crane et al, like Applicant disclose a

radiometal and a value of the variable  $n$  that is encompassed by the instant invention. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the inventions disclose overlapping subject matter.

**Note:** Grant et al, 1987, Grant & Hackh's Chemical Dictionary, 5<sup>th</sup> Edition, page 412, that is attached to this document, is being made of record to illustrate the definition of the terms 'organic chemistry' and 'organic compounds' as recognized in the art. Specifically, the term 'organic chemistry' is defined as the study of carbon compounds. The term 'organic compounds' encompasses non-polar compounds which *generally* consist of carbon and hydrogen, with or without oxygen, nitrogen, or other elements. Thus, based on the definitions provided by Grant et al, the skilled artisan would one again recognize that the amended claims are encompassed by the cited prior art.

## **NEW GROUNDS OF REJECTION**

### **New Matter Rejection**

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims contain new matter because review of the does not set forth wherein Applicant's variable L was referred to as 'a non-radioactive organic ligand'. Instead, throughout the specification, the variable L is referred to as the 'organic ligand'. Thus, the phrase '**non-radioactive** organic ligand' contains new matter. While the phrase, 'non-radioactive organic ligand' appears in independent claim 1, line 7, claims 2-14 depend on independent claim 1. As a result, those dependent claims (claims 2-14) also contain new matter.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D L. Jones whose telephone number is (571)272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D L. Jones/  
Primary Examiner  
Art Unit 1618

October 30, 2009